

FIRST CLASS MAILING CERTIFICATE

*Appeal Brief
MS. Zimmerman*

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail under 37 C.F.R. §1.8 in an envelope addressed to MS Appeal Brief-Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on May 19, 2003.



Karen L. Knudson
Karen L. Knudson

APPEAL BRIEF			Docket No. BTO019USPT01
Serial No. 09/264,762	Filing Date March 9, 1999	Examiner John Sotomayor	Group Art Unit 3714
Applicant: Jurmain			
Invention: DEVICE FOR SIMULATING SOME ASPECTS OF CIGARETTE USE			

**Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450**

TECHNOLOGY CENTER R3700

RECEIVED
MAY 28 2003

Dear Sir:

This brief is filed on appeal from the decision of the Examiner mailed December 16, 2002 finally rejecting all pending claims in the above-referenced patent application.

This brief is being submitted in triplicate in accordance with 35 C.F.R. 1.192(a), along with the necessary filing fee as set forth in 35 C.F.R. 1.17(c).

REAL PARTY IN INTEREST

The real party in interest in connection with this appeal is Realityworks, Inc., f/k/a Baby Think It Over, Inc., as assignee of the entire right, title, and interest in the application from the inventor Richard N. Jurmain.

05/23/2003 CNGUYEN 00000096 09264762

01 FC:2402

160.00 0P

RELATED APPEALS AND INTERFERENCES

Appellant and appellant's legal representative are unaware of any other appeal or interference which will directly affect, be directly affected by, or have a bearing on the Board's decision in the pending appeal.

STATUS OF CLAIMS

The application was filed on March 9, 1999. The application was originally filed with claims 1-42. Claims 1, 12, 27, 28, 32, 35-37 and 39 were amended and claim 31 canceled in an Amendment & Response mailed on September 30, 2002. Claims 1-30 and 32-42 remain pending in the application. No claims have been allowed.

The rejection of claims 1-30 and 32-42 is appealed. A copy of the claims involved in this appeal is provided in the Appendix section of this Brief in accordance with 37 C.F.R. 1.192(c)(9).

STATUS OF AMENDMENTS

No amendment has been filed subsequent to final rejection of the appealed claims.

SUMMARY OF THE INVENTION

A First Embodiment of the Claimed Invention (claims 1-11) is directed to an addiction simulator for education about and deterrence of drug use. The simulator includes (i) an enclosure, (ii) an electronic circuit housed within the enclosure, (iii) an actuator electrically interconnected to the electronic circuit, and (iv) a pushbutton switch responsive to an activity of a user of the addiction simulator which simulates participation in an addictive activity involving drug use.

A Second Embodiment of the Claimed Invention (claims 12-21) is directed to a portable personality simulator for achieving behavior modification and education of a user of the simulator. The simulator includes (i) a case, (ii) an electronic circuit housed within the case, and (iii) a speaker housed within the case and electrically interconnected to the electronic circuit for emitting spoken words commanding a user to behave in a desired manner.

A Third Embodiment of the Claimed Invention (claims 22-30 and 32) is directed to an entertainment device including (i) a case, (ii) a power source, (iii) a programmable electronic circuit powered by the power source, (iv) a voice synthesizer electrically interconnected to the programmable electronic circuit for issuing spoken prompts and taunts to a user of the entertainment device, and (v) a communications port permitting interconnection of the entertainment device to another entertainment device for exchanging programmed information.

A Fourth Embodiment of the Claimed Invention (claims 33-42) is directed to a portable personality simulator including (i) a case, (ii) a programmable electronic circuit housed within the case, and (iv) a speech synthesizer electrically interconnected to the programmable electronic circuit for issuing commands simulating a particular type of personality.

ISSUES

1. Whether claims 1, 2, and 4 are anticipated by Bonnett (United States Patent No. 4,138,722).
2. Whether claims 22-24 are anticipated by Schneier et al. (United States Patent No. 5,871,398).
3. Whether claims 3, 6, 8-11, 30 and 42 are obvious over Bonnett (United States Patent No. 4,138,722) in view of Schneier et al. (United States Patent No. 5,871,398).

4. Whether claim 12 is obvious over Bonnett (United States Patent No. 4,138,722) in view of Brown (United States Patent No. 5,918,603) and further in view of Best (United States Patent No. 4,445,187).

5. Whether claims 13, 15-16 and 19-21 are obvious over Bonnett (United States Patent No. 4,138,722) in view of Brown (United States Patent No. 5,918,603).

6. Whether claims 14, 17-18, 25-26, 29, 32-34 and 37-41 are obvious over Bonnett (United States Patent No. 4,138,722) in view of Brown (United States Patent No. 5,918,603) and further in view of Schneier et al. (United States Patent No. 5,871,398).

7. Whether claims 27-28 are obvious over Bonnett (United States Patent No. 4,138,722) in view of Hillsman (United States Patent No. 4,984,158).

8. Whether claims 35 and 36 are obvious over Bonnett (United States Patent No. 4,138,722) in view of Brown (United States Patent No. 5,918,603) and further in view of Knight et al. (United States Patent No. 5,676,551).

GROUPING OF CLAIMS

1. Rejected claims 1, 2, and 4 stand or fall together with respect to the anticipation rejection of these claims over Bonnett (United States Patent No. 4,138,722).

2. Rejected claims 22-24 stand or fall together with respect to the anticipation rejection of these claims over Schneier et al. (United States Patent No. 5,871,398).

3. Rejected claims 3, 6, 8-11, 30 and 42 do NOT stand or fall together with respect to rejection of these claims as obvious over Bonnett (United States Patent No. 4,138,722) in view of Schneier et al. (United States Patent No. 5,871,398). Rejected claims 3, 6 and 8-11 stand or fall together as a group with respect to this rejection. Claim 30 stands or falls alone with respect to this rejection. Claim 42 also stands or falls alone with respect to this rejection.

4. The rejection of claim 12 as obvious over Bonnett (United States Patent No. 4,138,722) in view of Brown (United States Patent No. 5,918,603) and further in view of Best (United States Patent No. 4,445,187) involves only a single claim and therefore does not need to be addressed in this section of the Brief.

5. Rejected claims 13, 15-16 and 19-21 stand or fall together with respect to the rejection of these claims as obvious over Bonnett (United States Patent No. 4,138,722) in view of Brown (United States Patent No. 5,918,603).

6. Rejected claims 14, 17-18, 25-26, 29, 32-34 and 37-41 do NOT stand or fall together with respect to rejection of these claims as obvious over Bonnett (United States Patent No. 4,138,722) in view of Brown (United States Patent No. 5,918,603) and further in view of Schneier et al. (United States Patent No. 5,871,398). Rejected claims 14 and 17-18 stand or fall together as a first group with respect to this rejection. Rejected claims 25-26, 29 and 32 stand or fall together as a second group with respect to this rejection. Rejected claims 33-34 and 37-41 stand or fall together as a third group with respect to this rejection.

7. Rejected claims 27 and 28 stand or fall together with respect to the rejection of these claims as obvious over Bonnett (United States Patent No. 4,138,722) in view of Hillsman (United States Patent No. 4,984,158).

8. Rejected claims 35 and 36 stand or fall together with respect to the rejection of these claims as obvious over Bonnett (United States Patent No. 4,138,722) in view of Brown (United States Patent No. 5,918,603) and further in view of Knight et al. (United States Patent No. 5,676,551).

ARGUMENT

Objections/Rejections Under 35 U.S.C. §§ 102 or 103

1.0 *The Examiner has rejected claims 1, 2, and 4 as anticipated by Bonnett (United States Patent No. 4,138,722).*

SUMMARY OF CITED REFERENCE

Bonnett discloses a device for automatically counting the number of times a smoker inhales upon a tobacco product, such as a cigarette. The device includes a pocket calculator, a pressure sensitive switch and a cigarette holder. The pressure sensitive switch is in fluid communication with the internal chamber of the cigarette holder for detecting a decrease in pressure within the holder caused by a smoker inhaling upon a cigarette positioned within the holder. The pressure sensitive switch is in electrical communication with the pocket calculator for summing and visually displaying the number of detected inhalations.

SUMMARY OF CLAIMED INVENTION

The First Embodiment of the Claimed Invention (claims 1-11) is directed to an addiction simulator for education about and deterrence of drug use. The simulator includes (i) an enclosure, (ii) an electronic circuit housed within the enclosure, (iii) an actuator electrically interconnected to the electronic circuit, and (iv) a pushbutton switch responsive to an activity of a user of the addiction simulator which simulates participation in an addictive activity involving drug use.

LEGAL BASIS FOR ESTABLISHING ANTICIPATION

An anticipation rejection under 35 U.S.C. §102 requires that the cited reference(s) disclose each and every element of the claimed invention. See, Hybritech Inc. v. Monoclonal Antibodies, Inc., 231 U.S.P.Q. 81, 90 (Fed. Cir. 1986); Kloster Speedsteel AB et al. v. Crucible Inc. et al., 230 U.S.P.Q. 81, 84 (Fed. Cir. 1986). Accordingly, the “exclusion of a claimed element from a prior art reference is enough to negate anticipation by that reference.” Atlas Powder Co. v. E.L duPont De Nemours & Co., 224 U.S.P.Q. 409, 411 (Fed. Cir. 1984).

BONNETT DOES NOT DISCLOSE
EACH AND EVERY ELEMENT OF THE CLAIMED INVENTION

The Claimed Invention includes a pushbutton switch responsive to an activity of a user which simulates participation in an addictive activity involving drug use (e.g., inhaling upon a straw simulating smoking of a cigarette). Bonnett discloses an invention which includes a pressure-sensitive switch responsive to actual smoking of a cigarette. Without an actual cigarette positioned within the cigarette holder, inhalation on the cigarette holder will not be detected by the pressure switch as the internal chamber of the cigarette holder is open to the atmosphere and a vacuum cannot be created within the holder.

2.0 *The Examiner has rejected claims 22-24 as anticipated by Schneier et al. (United States Patent No. 5,871,398).*

SUMMARY OF CITED REFERENCE

Schneier discloses a hand-held, off-line remote gambling system. The device includes a case, a power source, a programmable electronic circuit powered by the power source, a programmable sound synthesizer, and communications ports. The communications ports permit connection to a modem [158], a bar code scanner [152], a printer interface [150a] and printer [150b], a plug-in card interface [154] and a read/write interface [156].

SUMMARY OF CLAIMED INVENTION

A Third Embodiment of the Claimed Invention (claims 22-30 and 32) is directed to an entertainment device including (i) a case, (ii) a power source, (iii) a programmable electronic circuit powered by the power source, (iv) a voice synthesizer electrically interconnected to the programmable electronic circuit for issuing spoken prompts and taunts to a user of the entertainment device, and (v) a communications port permitting interconnection of the entertainment device to another entertainment device for exchanging programmed information.

LEGAL BASIS FOR ESTABLISHING ANTICIPATION

An anticipation rejection under 35 U.S.C. §102 requires that the cited reference(s) disclose each and every element of the claimed invention. See, Hybritech Inc. v. Monoclonal Antibodies, Inc., 231 U.S.P.Q. 81, 90 (Fed. Cir. 1986); Kloster Speedsteel AB et al. v. Crucible Inc. et al., 230 U.S.P.Q. 81, 84 (Fed. Cir. 1986). Accordingly, the “exclusion of a claimed element from a prior art reference is enough to negate anticipation by that reference.” Atlas Powder Co. v. E.L duPont De Nemours & Co., 224 U.S.P.Q. 409, 411 (Fed. Cir. 1984).

SCHNEIER DOES NOT DISCLOSE EACH AND EVERY ELEMENT OF THE CLAIMED INVENTION

The Third Embodiment of the Claimed Invention includes a voice synthesizer for issuing spoken prompts and taunts to a user of the entertainment device. Schneier discloses a sound synthesizer, but does NOT disclose a voice synthesizer for issuing spoken prompts and taunts to a user of the entertainment device. Schneier discloses use of the sound synthesizer to generate game sounds (e.g., dings and bells).

The Third Embodiment of the Claimed Invention further includes a communications port permitting interconnection of the entertainment device to another entertainment device for exchanging programmed information. Schneier discloses a variety of communications ports for permitting the gaming device to communicate with a variety of peripherals, but does NOT disclose a communications port permitting interconnection of the entertainment device to another entertainment device for exchanging programmed information.

3.0 *The Examiner has rejected claims 3, 6, 8-11, 30 and 42 as obvious over Bonnett (United States Patent No. 4,138,722) in view of Schneier et al. (United States Patent No. 5,871,398).*

SUMMARY OF CITED REFERENCES

Bonnett discloses a device for automatically counting the number of times a smoker inhales upon a tobacco product, such as a cigarette. The device includes a pocket calculator, a

pressure sensitive switch and a cigarette holder. The pressure sensitive switch is in fluid communication with the internal chamber of the cigarette holder for detecting a decrease in pressure within the holder caused by a smoker inhaling upon a cigarette positioned within the holder. The pressure sensitive switch is in electrical communication with the pocket calculator for summing and visually displaying the number of detected inhalations.

Schneier discloses a hand-held, off-line remote gambling system. The device includes a case, a power source, a programmable electronic circuit powered by the power source, a programmable sound synthesizer, and communications ports. The communications ports permit connection to a modem [158], a bar code scanner [152], a printer interface [150a] and printer [150b], a plug-in card interface [154] and a read/write interface [156].

SUMMARY OF CLAIMED INVENTION

A First Embodiment of the Claimed Invention (claims 1-11) is directed to an addiction simulator for education about and deterrence of drug use. The simulator includes (i) an enclosure, (ii) an electronic circuit housed within the enclosure, (iii) an actuator electrically interconnected to the electronic circuit, and (iv) a pushbutton switch responsive to an activity of a user of the addiction simulator which simulates participation in an addictive activity involving drug use.

A Third Embodiment of the Claimed Invention (claims 22-30 and 32) is directed to an entertainment device including (i) a case, (ii) a power source, (iii) a programmable electronic circuit powered by the power source, (iv) a voice synthesizer electrically interconnected to the programmable electronic circuit for issuing spoken prompts and taunts to a user of the entertainment device, and (v) a communications port permitting interconnection of the entertainment device to another entertainment device for exchanging programmed information.

A Fourth Embodiment of the Claimed Invention (claims 33-42) is directed to a portable personality simulator including (i) a case, (ii) a programmable electronic circuit housed

within the case, and (iv) a speech synthesizer electrically interconnected to the programmable electronic circuit for issuing commands simulating a particular type of personality.

LEGAL BASIS FOR ESTABLISHING
A PRIMA FACIE CASE OF OBVIOUSNESS

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation; either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, NOT in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). *See*, M.P.E.P. § 2143.

PRIOR ART REFERENCES DO NOT TEACH OR SUGGEST ALL OF THE
CLAIM LIMITATIONS OF THE CLAIMED INVENTION.

FIRST EMBODIMENT

The First Embodiment of the Claimed Invention includes a pushbutton switch responsive to an activity of a user which simulates participation in an addictive activity involving drug use (e.g., inhaling upon a straw simulating smoking of a cigarette). Bonnett discloses an invention which includes a pushbutton switch responsive to actual smoking of a cigarette. Without an actual cigarette positioned within the cigarette holder, inhalation on the cigarette holder will not be detected by the pressure switch as the internal chamber of the cigarette holder is open to the atmosphere and a vacuum cannot be created within the holder. Schneier discloses nothing which could be equated to a pushbutton switch responsive to an activity of a user which simulates participation in an addictive activity involving drug use.

THIRD EMBODIMENT

The Third Embodiment of the Claimed Invention includes a voice synthesizer for issuing spoken prompts and taunts to a user of the entertainment device. Neither Bonnett nor Schneier disclose a voice synthesizer for issuing spoken prompts and taunts to a user of the entertainment device. Bonnett is silent as to a speech synthesizer and Schneier discloses only a sound synthesizer for generating game sounds (*e.g.*, dings and bells).

FOURTH EMBODIMENT

The Fourth Embodiment of the Claimed Invention includes a speech synthesizer for issuing commands simulating a particular type of personality. Neither Bonnett nor Schneier disclose a speech synthesizer for issuing commands simulating a particular type of personality. Bonnett is silent as to a speech synthesizer and Schneier discloses only a sound synthesizer for generating game sounds (*e.g.*, dings and bells).

4.0 *The Examiner has rejected claim 12 as obvious over Bonnett (United States Patent No. 4,138,722) in view of Brown (United States Patent No. 5,918,603) and further in view of Best (United States Patent No. 4,445,187).*

SUMMARY OF CITED REFERENCES

Bonnett discloses a device for automatically counting the number of times a smoker inhales upon a tobacco product, such as a cigarette. The device includes a pocket calculator, a pressure sensitive switch and a cigarette holder. The pressure sensitive switch is in fluid communication with the internal chamber of the cigarette holder for detecting a decrease in pressure within the holder caused by a smoker inhaling upon a cigarette positioned within the holder. The pressure sensitive switch is in electrical communication with the pocket calculator for summing and visually displaying the number of detected inhalations.

Brown discloses a video game system programmed with a game which provides a medical patient with therapeutic treatment and/or information for the patient's medical condition. The video game includes a case, an electronic circuit housed within the case, and a speaker for emitting sounds associated with video games (*e.g.*, dings, bells, tones and tunes). Brown further discloses at column 7, lines 10-16 that characters depicted in the video game can communicate

instructions and strategies to the patient, but does not specify whether such communication is audible or visual.

Best discloses a video game system programmed to permit characters to reply responsively with lip-sync sound to words input by a viewer.

SUMMARY OF CLAIMED INVENTION

A Second Embodiment of the Claimed Invention (claims 12-21) is directed to a portable personality simulator for achieving behavior modification and education of a user of the simulator. The simulator includes (i) a case, (ii) an electronic circuit housed within the case, and (iii) a speaker housed within the case and electrically interconnected to the electronic circuit for emitting spoken words commanding a user to behave in a desired manner.

LEGAL BASIS FOR ESTABLISHING A PRIMA FACIE CASE OF OBVIOUSNESS

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation; either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, NOT in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). *See*, M.P.E.P. § 2143.

PRIOR ART REFERENCES DO NOT TEACH OR SUGGEST ALL OF THE CLAIM LIMITATIONS OF THE CLAIMED INVENTION.

The Second Embodiment of the Claimed Invention includes a speaker for emitting spoken words commanding a user to behave in a desired manner. Bonnett does not disclose a speaker. Brown discloses a speaker for emitting sounds associated with video games (*e.g.*, dings,

belts, tones and tunes), but does NOT disclose emitting spoken words commanding a user to behave in a desired manner. Brown does disclose at column 7, lines 10-16 that characters depicted in the video game can communicate instructions and strategies to the patient. However, Brown does not specify whether such communication is audible or visual. Brown discloses at column 4, lines 5-7 that the speaker is effective for "... producing sounds associated with video games ...". Since video games, such as the SUPER NINTENDO™ system referenced in Brown, generate only simplistic dings, belts, tones and tunes and do NOT generate speech, those skilled in the art are taught by Brown to communicate instructions and strategies by a visual display and NOT by audible speech. Best discloses a speaker for emitting lip-sync responses to words input by a viewer, but does NOT disclose emitting spoken words commanding a user to behave in a desired manner.

5.0 *The Examiner has rejected claims 13, 15-16 and 19-21 as obvious over Bonnett (United States Patent No. 4,138,722) in view of Brown (United States Patent No. 5,918,603).*

SUMMARY OF CITED REFERENCES

Bonnett discloses a device for automatically counting the number of times a smoker inhales upon a tobacco product, such as a cigarette. The device includes a pocket calculator, a pressure sensitive switch and a cigarette holder. The pressure sensitive switch is in fluid communication with the internal chamber of the cigarette holder for detecting a decrease in pressure within the holder caused by a smoker inhaling upon a cigarette positioned within the holder. The pressure sensitive switch is in electrical communication with the pocket calculator for summing and visually displaying the number of detected inhalations.

Brown discloses a video game system programmed with a game which provides a medical patient with therapeutic treatment and/or information for the patient's medical condition. The video game includes a case, an electronic circuit housed within the case, and a speaker for emitting sounds associated with video games (*e.g.*, dings, belts, tones and tunes). Brown further discloses at column 7, lines 10-16 that characters depicted in the video game can communicate instructions and strategies to the patient, but does not specify whether such communication is audible or visual.

SUMMARY OF CLAIMED INVENTION

A Second Embodiment of the Claimed Invention (claims 12-21) is directed to a portable personality simulator for achieving behavior modification and education of a user of the simulator. The simulator includes (i) a case, (ii) an electronic circuit housed within the case, and (iii) a speaker housed within the case and electrically interconnected to the electronic circuit for emitting spoken words commanding a user to behave in a desired manner.

LEGAL BASIS FOR ESTABLISHING A PRIMA FACIE CASE OF OBVIOUSNESS

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation; either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, NOT in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). *See*, M.P.E.P. § 2143.

PRIOR ART REFERENCES DO NOT TEACH OR SUGGEST ALL OF THE CLAIM LIMITATIONS OF THE CLAIMED INVENTION.

The Second Embodiment of the Claimed Invention includes a speaker for emitting spoken words commanding a user to behave in a desired manner. Bonnett does not disclose a speaker. Brown discloses a speaker for emitting sounds associated with video games (e.g., dings, bells, tones and tunes), but does NOT disclose emitting spoken words commanding a user to behave in a desired manner. Brown does disclose at column 7, lines 10-16 that characters depicted in the video game can communicate instructions and strategies to the patient. However, Brown does not specify whether such communication is audible or visual. Brown discloses at column 4, lines 5-7 that the speaker is effective for "... producing sounds associated with video

games ...". Since video games, such as the SUPER NINTENDO™ system referenced in Brown, generate only simplistic dings, bells, tones and tunes and do NOT generate speech, those skilled in the art are taught by Brown to communicate instructions and strategies by a visual display and NOT by audible speech.

6.0 *The Examiner has rejected claims 14, 17, 18, 25-26, 29, 32-34, and 37-41 as obvious over Bonnett (United States Patent No. 4,138,722) in view of Brown (United States Patent No. 5,918,603) in further view of Schneier et al. (United States Patent No. 5,871,398).*

SUMMARY OF CITED REFERENCES

Bonnett discloses a device for automatically counting the number of times a smoker inhales upon a tobacco product, such as a cigarette. The device includes a pocket calculator, a pressure sensitive switch and a cigarette holder. The pressure sensitive switch is in fluid communication with the internal chamber of the cigarette holder for detecting a decrease in pressure within the holder caused by a smoker inhaling upon a cigarette positioned within the holder. The pressure sensitive switch is in electrical communication with the pocket calculator for summing and visually displaying the number of detected inhalations.

Brown discloses a video game system programmed with a game which provides a medical patient with therapeutic treatment and/or information for the patient's medical condition. The video game includes a case, an electronic circuit housed within the case, and a speaker for emitting sounds associated with video games (e.g., dings, bells, tones and tunes). Brown further discloses at column 7, lines 10-16 that characters depicted in the video game can communicate instructions and strategies to the patient, but does not specify whether such communication is audible or visual.

Schneier discloses a hand-held, off-line remote gambling system. The device includes a case, a power source, a programmable electronic circuit powered by the power source, a programmable sound synthesizer, and communications ports. The communications ports permit connection to a modem [158], a bar code scanner [152], a printer interface [150a] and printer [150b], a plug-in card interface [154] and a read/write interface [156].

SUMMARY OF CLAIMED INVENTION

A Second Embodiment of the Claimed Invention (claims 12-21) is directed to a portable personality simulator for achieving behavior modification and education of a user of the simulator. The simulator includes (i) a case, (ii) an electronic circuit housed within the case, and (iii) a speaker housed within the case and electrically interconnected to the electronic circuit for emitting spoken words commanding a user to behave in a desired manner.

A Third Embodiment of the Claimed Invention (claims 22-30 and 32) is directed to an entertainment device including (i) a case, (ii) a power source, (iii) a programmable electronic circuit powered by the power source, (iv) a voice synthesizer electrically interconnected to the programmable electronic circuit for issuing spoken prompts and taunts to a user of the entertainment device, and (v) a communications port permitting interconnection of the entertainment device to another entertainment device for exchanging programmed information.

A Fourth Embodiment of the Claimed Invention (claims 33-42) is directed to a portable personality simulator including (i) a case, (ii) a programmable electronic circuit housed within the case, and (iv) a speech synthesizer electrically interconnected to the programmable electronic circuit for issuing commands simulating a particular type of personality.

LEGAL BASIS FOR ESTABLISHING A PRIMA FACIE CASE OF OBVIOUSNESS

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation; either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable

expectation of success must be found in the prior art, NOT in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). *See*, M.P.E.P. § 2143.

PRIOR ART REFERENCES DO NOT TEACH OR SUGGEST ALL OF THE
CLAIM LIMITATIONS OF THE CLAIMED INVENTION.

SECOND EMBODIMENT

The Second Embodiment of the Claimed Invention includes a speaker for emitting spoken words commanding a user to behave in a desired manner. Bonnett does not disclose a speaker. Brown discloses a speaker for emitting sounds associated with video games (e.g., dings, bells, tones and tunes), but does NOT disclose emitting spoken words commanding a user to behave in a desired manner. Brown does disclose at column 7, lines 10-16 that characters depicted in the video game can communicate instructions and strategies to the patient. However, Brown does not specify whether such communication is audible or visual. Brown discloses at column 4, lines 5-7 that the speaker is effective for "... producing sounds associated with video games ...". Since video games, such as the SUPER NINTENDO™ system referenced in Brown, generate only simplistic dings, bells, tones and tunes and do NOT generate speech, those skilled in the art are taught by Brown to communicate instructions and strategies by a visual display and NOT by audible speech. Schneier discloses a sound synthesizer, but does NOT disclose a speaker for emitting spoken words commanding a user to behave in a desired manner. Schneier discloses use of the sound synthesizer to generate game sounds (e.g., dings and bells).

THIRD EMBODIMENT

The Third Embodiment of the Claimed Invention includes a voice synthesizer for issuing spoken prompts and taunts to a user of the entertainment device. Bonnett does not disclose a voice synthesizer. Brown discloses a speaker for emitting sounds associated with video games (e.g., dings, bells, tones and tunes), but does NOT disclose a voice synthesizer for issuing spoken prompts and taunts to a user of the video game. Brown does disclose at column 7, lines 10-16 that characters depicted in the video game can communicate instructions and strategies to the patient. However, Brown does not specify whether such communication is audible or visual.

Brown discloses at column 4, lines 5-7 that the speaker is effective for "... producing sounds associated with video games ...". Since video games, such as the SUPER NINTENDO™ system referenced in Brown, generate only simplistic dings, bells, tones and tunes and do NOT generate speech, those skilled in the art are taught by Brown to communicate instructions and strategies by a visual display and NOT by audible speech. Schneier discloses a sound synthesizer, but does NOT disclose a voice synthesizer for issuing spoken prompts and taunts to a user of the entertainment device. Schneier discloses use of the sound synthesizer to generate game sounds (e.g., dings and bells).

The Third Embodiment of the Claimed Invention further includes a communications port permitting interconnection of the entertainment device to another entertainment device for exchanging programmed information. Bonnett does not disclose any type of communications port other than that associated with the pressure switch.. Brown discloses a communications port for communicating with a remote communication unit, but does NOT disclose a communications port permitting interconnection of the video game to another video game for exchanging programmed information. Schneier discloses a variety of communications ports for permitting the gaming device to communicate with a variety of peripherals, but does NOT disclose a communications port permitting interconnection of the entertainment device to another entertainment device for exchanging programmed information.

FOURTH EMBODIMENT

The Fourth Embodiment of the Claimed Invention includes a speech synthesizer for issuing commands simulating a particular type of personality. Bonnett, Brown and Schneier do not disclose a speech synthesizer for issuing commands simulating a particular type of personality. Bonnett is silent as to a speech synthesizer. Brown discloses a speaker for emitting sounds associated with video games (e.g., dings, bells, tones and tunes), but does NOT disclose a speech synthesizer for issuing commands simulating a particular type of personality. Brown does disclose at column 7, lines 10-16 that characters depicted in the video game can communicate instructions and strategies to the patient. However, Brown does not specify whether such communication is audible or visual. Brown discloses at column 4, lines 5-7 that the speaker is

effective for "... producing sounds associated with video games ...". Since video games, such as the SUPER NINTENDO™ system referenced in Brown, generate only simplistic dings, bells, tones and tunes and do NOT generate speech, those skilled in the art are taught by Brown to communicate instructions and strategies by a visual display and NOT by audible speech. Schneier discloses only a sound synthesizer for generating game sounds (e.g., dings and bells).

7.0 *The Examiner has rejected claims 27 and 28 as obvious over Bonnett (United States Patent No. 4,138,722) in view of Hillsman (United States Patent No. 4,984,158).*

SUMMARY OF CITED REFERENCES

Bonnett discloses a device for automatically counting the number of times a smoker inhales upon a tobacco product, such as a cigarette. The device includes a pocket calculator, a pressure sensitive switch and a cigarette holder. The pressure sensitive switch is in fluid communication with the internal chamber of the cigarette holder for detecting a decrease in pressure within the holder caused by a smoker inhaling upon a cigarette positioned within the holder. The pressure sensitive switch is in electrical communication with the pocket calculator for summing and visually displaying the number of detected inhalations.

Hillsman discloses a biofeedback training and evaluation system for instructing a patient on the proper techniques of inhalation to administer aerosol drugs with a metered dose inhaler. The biofeedback system includes (i) a microprocessor, (ii) a speaker for issuing auditory prompts to the user, and (iii) communications ports. The communications ports permit connection to monitors [8] and [10], a floppy or hard disk [17], a printer [20] and a keyboard [16].

SUMMARY OF CLAIMED INVENTION

A Third Embodiment of the Claimed Invention (claims 22-30 and 32) is directed to an entertainment device including (i) a case, (ii) a power source, (iii) a programmable electronic circuit powered by the power source, (iv) a voice synthesizer electrically interconnected to the programmable electronic circuit for issuing spoken prompts and taunts to a user of the

entertainment device, and (v) a communications port permitting interconnection of the entertainment device to another entertainment device for exchanging programmed information.

LEGAL BASIS FOR ESTABLISHING A PRIMA FACIE CASE OF OBVIOUSNESS

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation; either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, NOT in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). *See*, M.P.E.P. § 2143.

PRIOR ART REFERENCES DO NOT TEACH OR SUGGEST ALL OF THE CLAIM LIMITATIONS OF THE CLAIMED INVENTION.

The Third Embodiment of the Claimed Invention includes a communications port permitting interconnection of the entertainment device to another entertainment device for exchanging programmed information. Bonnett does not disclose any type of communications port other than that associated with the pressure switch.. Hillsman discloses a variety of communications ports for permitting the biofeedback training and evaluation system to communicate with a variety of peripherals, but does NOT disclose a communications port permitting interconnection of the biofeedback system to another biofeedback system for exchanging programmed information.

8.0 *The Examiner has rejected claims 35 and 36 as obvious over Bonnett (United States Patent No. 4,138,722) in view of Brown (United States Patent No. 5,918,603) in further view of Knight et al. (United States Patent No. 5,676,551).*

SUMMARY OF CITED REFERENCES

Bonnett discloses a device for automatically counting the number of times a smoker inhales upon a tobacco product, such as a cigarette. The device includes a pocket calculator, a pressure sensitive switch and a cigarette holder. The pressure sensitive switch is in fluid communication with the internal chamber of the cigarette holder for detecting a decrease in pressure within the holder caused by a smoker inhaling upon a cigarette positioned within the holder. The pressure sensitive switch is in electrical communication with the pocket calculator for summing and visually displaying the number of detected inhalations.

Brown discloses a video game system programmed with a game which provides a medical patient with therapeutic treatment and/or information for the patient's medical condition. The video game includes a case, an electronic circuit housed within the case, and a speaker for emitting sounds associated with video games (*e.g.*, dings, bells, tones and tunes). Brown further discloses at column 7, lines 10-16 that characters depicted in the video game can communicate instructions and strategies to the patient, but does not specify whether such communication is audible or visual.

Knight et al discloses a system in which users can ascribe emotional characteristics to a character or characters involved in a simulated interpersonal relationship presented in the form of a motion picture, television program, audio program, computer-generated images, etc.

SUMMARY OF CLAIMED INVENTION

A Fourth Embodiment of the Claimed Invention (claims 33-42) is directed to a portable personality simulator including (i) a case, (ii) a programmable electronic circuit housed within the case, and (iv) a speech synthesizer electrically interconnected to the programmable electronic circuit for issuing commands simulating a particular type of personality.

LEGAL BASIS FOR ESTABLISHING A PRIMA FACIE CASE OF OBVIOUSNESS

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation; either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, NOT in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). *See*, M.P.E.P. § 2143.

PRIOR ART REFERENCES DO NOT TEACH OR SUGGEST ALL OF THE CLAIM LIMITATIONS OF THE CLAIMED INVENTION.

The Fourth Embodiment of the Claimed Invention includes a speech synthesizer for issuing commands simulating a particular type of personality. Bonnett, Brown and Schneier do not disclose a speech synthesizer for issuing commands simulating a particular type of personality. Bonnett is silent as to a speech synthesizer. Brown discloses a speaker for emitting sounds associated with video games (*e.g.*, dings, bells, tones and tunes), but does NOT disclose a speech synthesizer for issuing commands simulating a particular type of personality. Brown does disclose at column 7, lines 10-16 that characters depicted in the video game can communicate instructions and strategies to the patient. However, Brown does not specify whether such communication is audible or visual. Brown discloses at column 4, lines 5-7 that the speaker is effective for "... producing sounds associated with video games ...". Since video games, such as the SUPER NINTENDO™ system referenced in Brown, generate only simplistic dings, bells, tones and tunes and do NOT generate speech, those skilled in the art are taught by Brown to communicate instructions and strategies by a visual display and NOT by audible speech. Knight et al. discloses ascribing emotional characteristics to simulated characters which will interact with other simulated characters in a motion picture, television program, audio program, computer-generated program, etc. Knight et al. does not disclose such characters issuing commands to a user of the system.

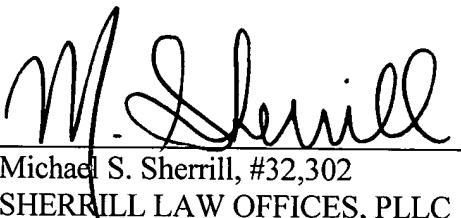
CONCLUSION

Applicant respectfully submits that claims 1-30 and 32-42 are in condition for allowance.

Respectfully submitted,

Date 19 May 03

By



Michael S. Sherrill, #32,302
SHERRILL LAW OFFICES, PLLC
4756 Banning Avenue, Suite 212
White Bear Lake, Minnesota 55110-3205
(651) 426-2400

APPENDIX

PENDING CLAIMS

*United States Patent Application
Serial No. 09/264,762*

1. An addiction simulator for education about and deterrence of drug use, comprising:
 - a. an enclosure;
 - b. an electronic circuit, the electronic circuit being housed within the enclosure;
 - c. an actuator, the actuator switch being electrically interconnected to the electronic circuit; and
 - d. a pushbutton switch, the pushbutton switch being responsive to an activity of a user of the addiction simulator which simulates participation in an addictive activity involving drugs.
2. The addiction simulator of claim 1, further comprising an alphanumeric display, the alphanumeric display being mounted to the enclosure so as to be visible to a user of the simulator, the alphanumeric display being interconnected to the electronic circuit, the alphanumeric display being responsive to actuations of the pushbutton switch.
3. The addiction simulator of claim 1, further comprising:
 - a. a slot, the slot being formed within a surface of the enclosure, the slot being dimensioned so as to permit the introduction of a thin material into the enclosure; and
 - b. a momentary contact switch mounted adjacent to the slot and electrically interconnected to the electronic circuit, the momentary contact switch sensing the presence of money within the slot.

4. The addiction simulator of claim 1, further comprising:
 - a. a bellows switch, the bellows switch being electronically interconnected to the electronic circuit; and
 - b. a breathing tube, the breathing tube passing from an interior region to an exterior region of the enclosure, the breathing tube being in fluid communication with the bellows switch such that inhaling through the breathing tube activates the bellows switch.
5. The addiction simulator of claim 1, further comprising a pressure sensor, the pressure sensor being electronically interconnected to the electronic circuit and fluidly interconnected to the breathing tube such that relative inhalation magnitudes can be sensed by the electronic circuit.
6. The addiction simulator of claim 1, further comprising a microphone, the microphone being electrically interconnected to the electronic circuit, the microphone detecting sounds made by a user of the simulator.
7. The addiction simulator of claim 1, further comprising a speaker, the speaker being interconnected to the electronic circuit, the speaker thereby issuing audible indications to a user of the simulator.
8. The addiction simulator of claim 1, wherein the electronic circuit further comprises a speech recognition circuit, the speech recognition circuit being programmed to recognize bodily sounds.
9. The addiction simulator of claim 1, wherein the electronic circuit further comprises a speech

recognition circuit, the speech recognition circuit being programmed to recognize mechanical sounds.

10. The addiction simulator of claim 4, wherein the breathing tube further comprises a whistle, the whistle producing a tone when a user of the simulator inhales through the tube, the speech recognition circuit being programmed to recognize the tone.

11. The addiction simulator of claim 7, wherein the electronic circuit further comprises a speech synthesizer, the speech synthesizer being electrically interconnected to the speaker, the speech synthesizer generating verbal messages to a user of the simulator.

12. A portable personality simulator for achieving behavior modification and education of a user of the simulator, comprising:

- (a) a case;
- (b) an electronic circuit housed within the case; and
- (c) a speaker, the speaker being housed within the case and being electrically interconnected to the electronic circuit, the speaker emitting spoken words commanding the user to behave in a desired manner.

13. The portable simulator of claim 12, further comprising at least one sensor, the sensor being electrically interconnected to the electronic circuit, the sensor detecting and verifying at least one behavioral act of the user in response to sounds emitted from the speaker.

14. The portable simulator of claim 13, wherein the sensor further comprises a microphone, the microphone detecting sounds made by the user.

15. The portable simulator of claim 12, further comprising a recess, the recess being formed within the case, the recess being adapted to secure an accessory used in association with the simulator.

16. The portable simulator of claim 12, further comprising a hypodermic simulation device, the hypodermic simulation device producing a signal when activated, the signal being sensed by a sensor and being subsequently processed by the electronic circuit.

17. The portable simulator of claim 12, further comprising an orifice formed within the case, the orifice being adapted to receive a substance simulating money, the substance being required in response to prompting of the user by sounds emitted by the speaker.

18. The portable simulator of claim 14, further comprising a speech synthesizer, the speech synthesizer being electrically interconnected to the electronic circuit, the speech synthesizer generating spoken questions which are emitted by the speaker, the microphone detecting user responses, the electronic circuit verifying the user response.

19. The portable simulator of claim 12, further comprising a visual display, the visual display being mounted to the case, the visual display being electrically interconnected to the electronic circuit, the visual display issuing messages to the user.

20. The portable simulator of claim 12, further comprising an orifice formed within the case, the orifice permitting introduction of air outside of the case into an interior region of the case.

21. The portable simulator of claim 20, further comprising a breathing apparatus, the breathing apparatus being affixed to the orifice, the breathing apparatus permitting the user to exhale into the interior region of the case.

22. An entertainment device, comprising:

a. a case;

b. a power source;

c. a programmable electronic circuit, the programmable electronic circuit being powered by the power source;

d. a voice synthesizer, the voice synthesizer being electrically interconnected to the programmable electronic circuit, the voice synthesizer issuing spoken prompts and taunts to a user of the entertainment device. and

e. a communications port, the communications port permitting interconnection of the entertainment device to another entertainment device, thereby permitting exchange of programmed information between devices.

23. The entertainment device of claim 22, further comprising a visual display, the visual display being electrically interconnected to the electronic circuit, the visual display issuing visual prompts and taunts to a user of the device.

24. The entertainment device of claim 23, further comprising a microphone, the microphone being electrically interconnected to an electronic circuit, the microphone receiving sounds produced by a user of the device, the electronic circuit generating prompts and taunts in response to sounds received by the microphone.

25. The entertainment device of claim 22, wherein the case further comprises:

- a. a bore passing through a surface of the case;
- b. a tube interconnected to the bore and extending outwardly from the case, the tube being adapted to permit a user of the device to exhale into and exhale from the case;
- c. at least one vent perforation formed within the case, the vent perforation permitting exhaled air passing through the tube into the case to exit from the case and to permit inhaled air to enter the case; and
- d. a flow restrictor, the flow restrictor affecting the effort which a user must exert to inhale through the tube.

26. The entertainment device of claim 22, further comprising a memory, the memory being electrically interconnected to the electronic circuit, the memory containing a plurality of messages which are used as prompts and taunts delivered to a user of the device.

27. The entertainment device of claim 26, wherein at least one of the plurality of messages contained in the memory is related to cigarette consumption by a user of the device.

28. The entertainment device of claim 26, wherein at least one of the plurality of messages contained in the memory is related to life expectancy of a user of the device.

29. The entertainment device of claim 27, further comprising a plurality of user selectable software choices, each user selectable software choice pertaining to a particular type of addictive behavior practiced by human beings.

30. The entertainment device of claim 28, wherein the case further comprises a slot, the slot being adapted to receive currency, the currency being required by the device to simulate purchase of a product being consumed by a user of the device.

32. The entertainment device of claim 29, wherein the memory simulates borrowing a quantity of the product from another entertainment device via the communications port.

33. A portable personality simulator, comprising:

- a case;
- a programmable electronic circuit housed within the case; and
- a speech synthesizer, the speech synthesizer being interconnected to the electronic circuit, the electronic circuit being programmed to issue commands simulating a particular type of personality.

34. The portable personality simulator of claim 33, further comprising:

- a microphone, the microphone being interconnected to the electronic circuit; and

b. a voice recognition device, the voice recognition device being interconnected to the electronic circuit and the microphone, the voice recognition circuit verifying that a user of the simulator has complied with the commands issued by the simulator.

35. The portable personality simulator of claim 34, wherein the particular type of personality is selected from:

- a. paternalism;
- b. superiority;
- c. humor; and
- d. demanding.

36. The portable personality simulator of claim 33, wherein the simulator is programmed to emulate the personality of a celebrity.

37. The portable personality simulator of claim 34, wherein the voice recognition device is programmed to identify a sound associated with at least one bodily function including:

- a. exhaling;
- b. coughing;
- c. snoring;
- d. vomiting;
- e. inhaling; and
- f. puffing

38. The portable personality simulator of claim 35, wherein the electronic circuit is programmed to analyze an intensity parameter related to the sound of a bodily function.

39. The portable personality simulator of claim 36, wherein the electronic circuit is programmed to identify a sound emanating from other than the simulator as an acceptable response to a given command issued by the simulator.

40. The portable personality simulator of claim 39, wherein at least one of the sounds identified by the electronic circuit includes:

- a. running water;
- b. flushing toilet;
- c. vacuum cleaner;
- d. dishwasher;
- e. motor running;
- f. striking a match;
- g. opening an aluminum can; and
- h. opening a refrigerator.

41. The portable personality simulator of claim 38, further comprising a recording function, the recording function producing a record of a user's compliance with commands issued by the simulator, the record being reportable to a person other than the user.

42. The portable personality simulator of claim 39, wherein the case further comprises a money

receptacle, the money receptacle permitting a user of the simulator to deposit money in response to commands issued by the simulator.